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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,605	03/20/2001	Richard E. Pearl	27200 / 04005	3834

24024 7590 01/02/2003

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EXAMINER

WEBB, GREGORY E

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 01/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/812,605

Applicant(s)

PEARL, RICHARD E.

Examiner

Gregory E. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 112

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "substantially" in claim 11 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is suggested that the applicant state on record what is intended by this relative term.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 are rejected under USC 102(b) as being anticipated by Harbin; Raymond H. (US Patent 5536439).

Concerning the isobutyl isobutyrate of claims 1-3, Harbin; Raymond H. teaches the following:

"It will be appreciated from the foregoing, that a cleaning composition
having excellent properties for removing a variety of paint residues may

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be prepared from a glycol ether-based solution of an alkali metal hydroxide together with another organic solvent. The specific components of the composition will depend upon particular applications and factors such as desired flash point, compatibility with handling and processing equipment and the like. In general, propylene or ethylene glycol ethers are favored, particularly propylene glycol monomethyl ether and ethylene glycol monobutyl ether. The organic solvents will typically comprise ketones, alcohols, esters and aromatic solvents, and most preferably include cyclohexanone, methyl isobutyl ketone, isobutyl isobutyrate, xylene and various aromatic blends." (see col. 6-7).

Concerning the organic contaminant of claims 1-3, Harbin; Raymond H. teaches the following:

"The present invention is directed to an organic based composition having a high degree of solvating power for a broad range of solvent-based and water-based paint materials including high solids paints as well as clear coats. The cleaning composition is particularly well suited for cleaning heavily pigmented deposits such as are found in paint lines, vats and on spray booth equipment." (see cols. 2-3).

Concerning the amount of IBIB and carrier, Harbin teaches in example 6 a composition containing the required IBIB and carrier.

Concerning the flash point, MIR, PIS and other properties stated in the claims, as Harbin has taught each of the physical limitations of the claims at hand, such properties as flash point, etc. would be inherent to these composition.

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Claims 1-10, 12 are rejected under USC 102(b) as being anticipated by Dixon; Donald R. (US Patent 4968447).

Concerning the isobutyl isobutyrate of claims 1-10, Dixon; Donald R. teaches the following:

"This composition comprises approximately 48.5% xylene, 17.2% dibasic ester, a paint solvent sold by the DuPont Corporation of Wilmington, Del.; approximately 24% isobutyl isobutyrate, an ester solvent for paint and approximately 9.3% Hercoflat .RTM. 1150 polypropylene powder. The foregoing ingredients were mixed together by simple agitation and were employed as will be described hereinbelow in a cleaning process." (see example 1).

Concerning the water of claims 12, Dixon; Donald R. teaches the following:

"3. A composition as in claim 1, wherein said vehicle includes water." (see claim 3).

Concerning the organic contaminant of claims 1-12, Dixon; Donald R. teaches the following:

"Presently, the paint delivery systems which are utilized for the finishing of a wide variety of manufactured items such as motor vehicles, household appliances and the like are becoming increasingly more sophisticated. A typical industrial paint delivery system may comprise a central paint supply having a number of painting stations communicating therewith. Such paint delivery systems can selectably deliver a variety of different paints to a given painting station and include complex fluid pathways involving various tanks, pumps and conduits. These paint delivery systems tend to become clogged with encrustations in the course of their use and

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such deposits can decrease and even block the flow of paint therethrough.

Such clogging is occasioned by deposits of pigment, resins or other components of the paint within the tanks and lines of the system. In addition to causing clogging, such deposits can also contaminate the paint color, and can cause surface defects in the finished, painted product.

Cleaning the paint delivery system reduces the amount of surface repairs to paint finishes." (see col. 1 lines 14-34).

Claims 1-12 are rejected under USC 102(b) as being anticipated by Roelofs; Robert R. (US Patent 5993562).

Concerning the organic contaminant of claims 1-12, Roelofs; Robert R. teaches the following:

"Thirteen gallons (49 liters) of the above pretreatment fluid was charged to a recirculation tank fitted with a section of dirty paint line from an automobile assembly plant. The paint line contained deposits of red metallic waterborne paint with a composition typical of waterborne formulations, similar to that of Example V above. This paint line segment represented a worst case for cleaning as the paint build-up was excessive, old, and included recently coagulated waterborne paint. This coagulated paint has proven difficult to remove in past field cleanings." (see example 6).

Concerning the isobutyl isobutyrate of claims 0, Roelofs; Robert R. teaches the use of a liquid carrier which includes isobutyl isobutyrate (see col. 6, lines 53-68).

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Concerning the amount of IBIB, Roelofs teaches the use of various carriers and solvents in the amounts required by claims 4-5 (see example 6).

Concerning claim 11, the composition of example 6 is free of these compounds.

Concerning the flash point, MIR, PIS and other properties stated in the claims, as Roelofs has taught each of the physical limitations of the claims at hand, such properties as flash point, etc. would be inherent to these composition.

Claims 1-10 are rejected under USC 102(b) as being anticipated by Yezrielev; Albert Ilya (US Patent 6280519).

Concerning the isobutyl isobutyrate of claims 1-2, 8-10, Yezrielev; Albert Ilya teaches the preferred fluids as follows:

"isobutyrate compounds such as methyl isobutyrate, isopropyl isobutyrate, neopentyl isobutyrate, and neopentyl glycol mono isobutyrate; and" (see col. 7 lines 63-65).

Concerning the organic contaminant of claims 1-12, Yezrielev; Albert Ilya teaches the following:

"The present invention offers fluids and fluid blends for use in a variety of industrial applications such as paints and other coatings, adhesives, sealants, agricultural chemicals, cleaning solution, consumer products such as cosmetics, pharmaceuticals, drilling muds, extraction, reaction diluents, inks, metalworking fluids, etc." (see col. 14 lines 58-63).

In example 2, Yezrielev teaches a composition containing at least 10% esters, and a carrier (as per claims 1, 4, 5)

Double Patenting

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-12 are rejected under the judicially created doctrine of double patenting over claims 1-18 of U. S. Patent No. 6,235,694 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Concerning the isobutyl isobutyrate of claims 1-12, Pearl; Richard E. teaches the following:

"2. The process of claim 1, wherein a contaminant selected from the group consisting of dried latex paint, uncured organic solvent based paint, adhesives, ink, chewing gum, tars, greases, glues, animal fats, vegetable oils, tree sap and other lipophilic soil is removed by contact with isobutyl isobutyrate." (see claim 2).

Concerning the water of claims 1-4, 11-12, Pearl; Richard E. teaches the following:

"the composition further containing at least 1.0 wt. % of a compound selected from the group consisting of water, a liquid carrier capable of

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dissolving or being dissolved in the isobutyl isobutyrate, and mixtures thereof, the composition being essentially free of alkali metal hydroxides and" (see claim 18).

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

It is suggested that the applicant more clearly define both the composition and the process. Currently, the applicant's composition in claim 1 only requires one compound and does not exclude any additional compounds. The use of esters for removing paint is well known. The applicant should not rely on the properties of the composition such as MIR unless they are willing to demonstrate via a declaration that the prior art compositions do not meet these limitations. The examiner does not have the facilities to determine if these measurable quantities are met.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory E. Webb whose telephone number is 703-305-4945. The examiner can normally be reached on 9:00-17:30 (m-f).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 703-308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9310 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink, appearing to read 'Gregory E. Webb', with a stylized, cursive script.

Gregory E. Webb
Primary Examiner
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gw
December 27, 2002